

REMARKSSTATUS OF CLAIMS

The Office Action dated March 1, 2004 has been received and its contents carefully considered. Claims 2-26 are pending. Claim 23 has been canceled without prejudice or disclaimer. Claim 2-4, 7-11, 15, 17-21 and 24-26 have been amended. Claims 10, 21 and 26 are independent.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

OFFICE ACTION

Claim 19 was objected to because of noted informalities. Claims 2-25 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-9, 11-20 and 23-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Canders et al. (DE19727550A1). Claims 10, 21 and 22 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner is thanked for the indication of allowable subject matter. These objections and rejections are respectfully traversed with respect to the following reasons.

The claim objection has been obviated by the above amendments to claim 19 accordingly. The 35 U.S.C. §112, second rejection has been obviated by the above amendments as well.

Without conceding the propriety of the rejections, the present invention in amended claim 10 recites, in part, the first permanent magnet configuration comprises a first permanent magnet

concentrically disposed within a second permanent magnet. Canders et al. (DE19727550A1) shows a rotor assembly 12, a first superconducting magnetic bearing 11, a first permanent magnet configuration 11b, and a passive first super-conducting magnetic stator 11a. In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Thus, Canders et al. (DE19727550A1) cannot be said to teach or suggest the first permanent magnet configuration comprises a first permanent magnet concentrically disposed within a second permanent magnet.

In addition, the present invention in amended claim 21, recites, in part, the first permanent magnet configuration comprises at least two annular permanent magnets mounted concentrically one in another in a plane whereby the rings are radially adjacent fitted. Canders et al. (DE19727550A1) shows a rotor assembly 12, a first superconducting magnetic bearing 11, a first permanent magnet configuration 11b, and a passive first super-conducting magnetic stator 11a. In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Thus, Canders et al. (DE19727550A1) cannot be said to teach or suggest the first permanent magnet configuration comprises at least two annular permanent magnets mounted concentrically one in another in a plane whereby the rings are radially adjacent fitted.

Furthermore, the present invention in amended claim 26 recites, in part, wherein the permanent magnet configuration comprises an integrated lower part of the rotor unit, wherein first permanent magnet configuration comprises a first permanent magnet concentrically disposed within a second permanent magnet. Canders et al. (DE19727550A1) shows a rotor assembly 12, a first superconducting magnetic bearing 11, a first permanent magnet configuration 11b, and a passive first super-conducting magnetic stator 11a. In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Thus, Canders et al. (DE19727550A1) cannot be said to teach or suggest the first permanent magnet configuration comprises a first permanent magnet concentrically disposed within a second permanent magnet.

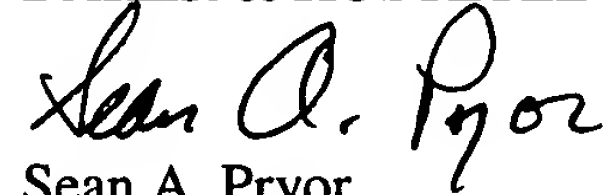
For the foregoing reasons, it is respectfully submitted that the invention recited in claims 10, 21 and 26 is patentable over Canders et al. (DE19727550A1). Thus, it is respectfully submitted that the remaining depending claims are allowable for at least the reasons given herein.

In view of the foregoing, reconsideration and allowance of the application are believed in order, and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned at 202/861-1748.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read "Sean A. Pryor". The signature is fluid and cursive, with the first name "Sean" and last name "Pryor" clearly distinguishable.

Sean A. Pryor

Registration No. 48,103

Date: June 1, 2004

Washington Square, Suite 1100

1050 Connecticut Avenue, N.W.

Washington, D.C. 20036-5304

Telephone: 202/861-1655

Facsimile: 202/861-1783